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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,188	02/01/1999	MICHAEL BLANDINA	10655.7117	8363

7590

11/19/2002

BRETT CARLSON INTELLECTUAL PROPERTY
SNELL AND WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 85004-2202

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/241,188

Applicant(s)

BLANDINA ET AL.

Examiner

James Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment of 30 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

An Office Action of 30 May 2002 rejected claims 20-35 as unpatentable over Schein in view of Owens. Applicants amended claims 20, 28 and 29, cancelled claim 24, and traversed rejection of claims 20-23 and 25-35.

Claims 20-23 and 25-35, a total of fifteen claims, remain and will be examined.

Response to Arguments

Applicants' arguments filed 30 August 2002 have been fully considered but they are not persuasive.

Applicants argue that Schein in no way creates, administers or facilitates multiple stored value products (amendment of 08/30/02, page 5, lines 9-10). Applicants argue that Schein is limited to a communication and messaging network and that Schein is not concerned with building or operating stored value products, and as such would have no need for a database or repository of objects suited for such a purpose. In response, Schien discloses that the system may add (i.e., create) relationships and records between users and clients based upon other criteria in the future (see at least Col. 17, line 37-Col. 18, line 8.).¹ Schein discloses that banks offer additional products or services and that customers may open accounts (see at least 4, lines 23-44). Several of these relationships may be found in Fig. 7 and related text, Col. 17, line 37-Col 18,

¹ Schien refers to *data models* that reflect the structure of a customer's relationship to a bank (Col. 3, line 65-Col. 4, line 12). Schien does not limit their invention to a bank, but discloses that a bank is only one example of a financial institution as a client system (see references to financial *institutions*, *emphasis added*). Schlein also do not limit their invention to the presence of a single stored value product.

line 58). Schein also discloses that database management systems create databases and structures and provides means for the control and administration of the data in the database (see at least Col. 6, line 53-Col. 7, line 47). Therefore, applicants' arguments are not persuasive.

Applicants argue that Schein does not mention client systems associated with at least one of the plurality of stored value products. Applicants rely on examiner's citation of Col. 7, lines 13-33. Applicants' attention is directed to Col. 6, lines 6-67, which describe a plurality of stored value products associated with CITIBANK client system. Schein discloses that brokerage firms such as MERRILL LYNCH also participate in offering financial products such as CITIBANK. Schein discloses that VISA CORPORATION may also use their invention (see at least Col. 21, lines 37-63) and that various other financial institutions and networks and participants of those networks may use their invention (Col. 22, lines 4-16). Even if one were to interpret Schein as limiting their invention to only one type of financial institution, (a bank) and only one client system (i.e., a single bank, perhaps CITIBANK as assignee of patent 6,226,623), Schein's use of multiple stored value products disclose applicants' use of the terms, as set forth in their disclosures. For stored value products, see page 2, lines 4-6, page 3, lines 4-9, page 7, lines 4-10. For clients and client systems, see page 7, line 11-page 8, line 8:

As shown in Figure 2A, client system 138 is any device or entity that is suitably configured to include particular functionalities and to interface with a common server. Client systems 138 preferably include only the functionality that is unique to the particular client system 138, such as, for example, sales and pricing information and interface handling. In other words, most common functionality is located and shared at database server 116 such as, for example, card/account creation, addition of funds, account information, report information and/or the like (the details of the functionality are

Art Unit: 3625

described below with respect to Figure 8). In a particularly preferred embodiment, client system 138 represents a particular brand of a smart card. Client systems 138 suitably transmit data to database server 116 corresponding to the creation of new stored value cards/accounts and to the addition of funds in the stored value account. In alternative embodiments of the invention, client systems 138 suitably receive data such as account information and report information from database server 116. Alternatively, as can be seen from Figure 213, database server 116 interacts with client systems 138 through intermediating modules such as report generator 136 and card production system 128. In other embodiments, client 138 resides on database server 116, operating as a separate process. In still other embodiments, clients 138 are eliminated entirely and consumers and business entities interact directly with database server 116.

Therefore, applicants' arguments that Schein does not mention client systems associated with at least one of the plurality of stored value products are not persuasive.

On page 6, lines 1-15 of their amendment, Applicants argue that Owens reference cited in the Office Action fails to disclose or suggest the remaining elements in the pending claims, in that (a) Owens is far removed from the field of their invention and because (b) Owens deals with programs that could be used by Internet customers to purchase goods or track funds using various bank accounts (Amendment, page 6, line 19-21).

In response to (a), Owens combines client-server nomenclature, object-oriented terminology in a financial environment that includes various types of financial products from one or more clients and one or more client systems (see at least Col. 5, line 36-Col. 6, line 10). Therefore, Owens is not removed from the field of their invention since Owens' sample applications include phone services, internet access services, frequent flyer miles and others (see at least Col. 1, lines 42-63). Owens' examples are similar to Applicants' stored value products (see disclosures, page 1, line 12-page 2, line 12). Owens discloses the use of relational databases (such as ORACLE, as claimed by

applicants on page 17, line 16- page 18, line of their disclosure). Therefore, applicants' arguments are not persuasive.

Moreover, even if one were to find that Owens is removed from the field of applicants' invention, it has been held that a prior art reference must either be in the field of applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

It is true that Owens does not use the term back-end or front-end. Owens also does not use the term *online wallet*, as stated by applicants. However, financial transactions and billing do not exist in a vacuum. Owens specifically discloses billing and transaction recording issues (see at least Col. 1, line 41 – Col. 28). Owens functions are consistent with applicants' references to billing as a back-end or back office functions (see at least references to billing and centralized functions in Disclosures, page 3, lines 4-14 and page 8, lines 9-16).

In response to (b), applicants' argument that Owens deals with programs that could be used by Internet customers to purchase goods or track funds using various bank accounts (amendment, page 6, lines 19-21), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, applicants' arguments are not persuasive.

In response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that there is no motivation or suggestion to combine Schein and Owens without impermissibly using applicants' claims as a guide. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Schein discloses applicants' invention but does not address issues of object-oriented analysis and design. Owens was first introduced in parent application 09/105406(now abandoned). Owens was re-introduced in the present application to address applicants' concern over the absence of the word *object* in Schein. Owens is used to show that object-oriented paradigms and their application to database technologies are (a) old and well known, (b) may be used in many types of computer

applications and software design, and (c) may be used particularly with financial products such as claimed by applicants. For purposes of definitions, object technology is the use of objects as building blocks for applications.² An object is a self-contained module of data and its associated processing.³ Applicants have neither argued nor shown that their use of object-related terminology (e.g., *object*, *object-oriented analysis*, *object-oriented design*, etc.) differs from the terms' widely accepted use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-23 and 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. U.S. Patent 6,226,623 (Schein) in view of Owens et al. (US Patent 6,047,267).

As per claim 20, Schein discloses a system and methods for creating and facilitating a plurality of stored value products, the system comprising:

(a) a plurality of client systems each of said client systems being associated with at least one of the plurality of stored value products (Schein discloses that banks

² The Computer Desktop Encyclopedia, Alan Freedman, copyright 1996.

- offer additional products or services and that customers may open accounts (i.e., Schein creates and facilitates plurality of financial products, including stored value products) see at least 4, lines 23-44). Schein describes a plurality of stored value products associated with a CITIBANK client system; Schein discloses that brokerage firms such as MERRILL LYNCH also participate in offering financial products such as CITIBANK's; Schein discloses that VISA CORPORATION may also use their invention (see at least Col. 6, lines 6-67, Col. 21, lines 37-63) and that various other financial institutions and networks and participants of those networks may use their invention (Col. 22, lines 4-16).
- (b) database facilitating the storage and retrieval of customer data, merchant data, and a plurality of data items (see at least, Col. 9, lines 42-47; see also references to centralized databases, Col. 10, lines 41-Col. 11, line 20);
 - (c) a transaction capture module configured to receive transaction data from a point-of-sale terminal configured to [receive] accept at least one of said plurality of stored value products (see at least, Col. 10, lines 41-56; Col. 20, lines 51-67; Col. 20, lines 51-67); and
 - (d) a *database server* configured to support [each of] said stored value products, to receive said transaction data from said transaction capture module, and to route said transaction data among said plurality of stored value products executing on said plurality of client systems; (see at least, Col. 9, line 62-Col. 10, line 7; see also at least references to multiple-user databases sharing of information and

³ The Computer Desktop Encyclopedia, Alan Freedman, copyright 1996.

- resources, Col. 7, lines 12-34; see references to location of various databases, including centralized data storage, and communication with various client systems that store and supply data to a centralized site, Col. 10, lines 41-56);
- (e) wherein each of said stored value products comprises a plurality of data items retrieved from said database (see at least, Col. 7, lines 13-33, describing service providers, financial institutions and their products, including stored-value products), and
- (f) wherein each of said plurality of data items provides a function that is available to each of the plurality of stored value products [such that]; and wherein each of said plurality of stored value products is allowed to retrieve said customer data and said merchant data from said database using at least a portion of said plurality of objects (see at least, Col. 10, lines 41-56; see also at least references to profiles stored in a single repository, Col. 10, lines 28-Col. 11, line 48).

Schein discloses a report generating system in communication with said database server, wherein the report generating system is configured to assemble reports based at least in part upon said transaction data (see Col. 6, lines 53-65).

Schein discloses an authorization server in communication with the database server and the point-of-sale terminal and wherein the point-of-sale terminal is configured to query the authorization server for transaction approvals (see at least, Col. 2, lines 7-17; Col. 22, lines 4-24; Fig. 13, Fig. 2, items 28, 46; Col. 3, lines 53-63).

Schein discloses a plurality of data items comprising consumer information that is available to each of a plurality of stored value products (see at least, Col. 10, lines 41-56).

Schein discloses a server facilitating the operation of a plurality of stored value programs, each of said stored-value programs being associated with one of a plurality of client systems, the server comprising:

- (a) a digital computer in communication with a database maintaining consumer information, merchant information and a plurality of data items (see at least, Col. 9, line 42-Col. 10, line 7);
- (b) wherein each of said plurality of data items is configured to facilitate a particular function and to associate with each of said plurality of stored value programs (see at least, Col. 7, lines 13-33, describing service providers, financial institutions and their products), and
- (c) wherein each of said plurality of stored value programs accesses said consumer information and said merchant information via at least one of said plurality of data items (see at least, Col. 10, lines 41-56);
- (d) such that said consumer information and said merchant information is available to each of said plurality of financial products through a common interface available from the plurality of client systems. (see description of a common interface called a Global Integration Facility/GIF Col. 14, lines 36-51; see also references to client systems sending information to a centralized system, Col. 10, lines 28-65).

Schein discloses a method of facilitating financial transactions at a server, the method comprising the steps of:

- (a) selecting a first plurality of objects from a repository of objects to form a first stored value program, said first stored value program corresponding to a first financial product and being associated with a first client system (see at least Col. 3, line 65-Col. 6, line 65 for description of the art related to forming a first stored value program and its corresponding financial product; Col. 4, lines 39-5Col. 11, lines 11-48; Col. 12, lines 21-49 describing linking of various customer accounts and financial products; see also claim 20, above);
- (b) selecting a second plurality of objects from said repository of objects to form a second stored value program, said second stored value program corresponding to a second financial product and being associated with a second client system (see at least Col. 3, line 65-Col. 6, line 65 for description of the art related to forming a first stored value program and its corresponding financial product; Col. 4, lines 39-5Col. 11, lines 11-48; Col. 12, lines 21-49 describing linking of various customer accounts and financial products); and
- (c) accessing a *database* comprising consumer information and merchant information by said first and second client systems such that said first and second stored value programs interact with said *database* via said first and second pluralities of objects, respectively, to implement said first and second financial products on said first and second client systems, respectively (see at least Col. 7, lines 13-33; Col. 10, lines 41-56; see also utilization of common

reports and customer demographic information available from stored objects that are created by any client system, Col. 10, lines 66-Col. 11, line 34).

Schein discloses receiving a transaction request from a point of sale terminal, said transaction request corresponding to one of said financial products (see at least Col. 10, lines 41-56, Col. 15, lines 41-52; Col. 20, line 51-Col. 22, line 3).

Schein discloses determining a financial product corresponding to a transaction request at a transaction server, and further comprising a step of processing a transaction request in accordance with a first (or *nth*) plurality of data items if a transaction request corresponds to a first financial product (or *nth*). See at least, Col. 10, lines 41-Col. 12, line 49, describing the types of information available from the database. The information on the database is available for each transaction, and the transaction request is linked to a customer's products. A customer may have many products, each product associated with an object. These data items may also be referred to as a first through *nth* product.

Schein discloses separating a first and second financial product based upon a key value where said key value corresponds to a business unit. (see at least, Col. 5, lines 5 -Col. 67; Col. 6, line 7-Col. 7, line 46; Col. 10, lines 41- Col. 11, line 10 describes Database Management Systems. Database systems rely on unique and non-unique keys to store and access information. A key may identify CITIBANK, see at least, or a key may identify the CMMA CITIBANK MONEY MANAGEMENT ACCOUNT, as a separate business unit, if desired).

In summary, Schein discusses all limitations of applicants' invention, including stored value products such as smartcards and ATM cards. Client system computers may be connected to servers via the Internet (see at least Fig. 3, and Col. 15, line 53-Col. 16, line 7, Col. 21, lines 4-36; Col. 9, lines 57-Col. 10, line 7). Schein mentions several types of persistent repository mechanisms, including DB2, ORACLE (Col. 9, lines 1-67; see also application, page 17, lines 16-3). Schein discloses that other data models and structures may be applied (see at least Col. 6, lines 7-45, profiles and data models) and points out problems that arise when several sections in one or more clients maintain application-specific data and programs (see at least Col. 6, lines 25-44). Classes and objects are another way of modeling & data in persistent storage.

Schein *does not* use the words class and objects. These words are found when one uses a data model called the "object-oriented" model. Owens discloses the use of relational databases in an object-oriented design in a multi-product on-line and Internet environment (see at least Abstract, Col. 1, lines 1-Col. 2, line 60, Col. 5, lines 36-Col. 7, line 30). Owens discloses a system for administering a plurality of financial resources in an object-oriented paradigm where persistent storage takes place in relational database management scheme (see at least references to SQL, the Structured Query Language that is used to access relational databases, Col. 1, lines 19-60).

Owens describes systems and methods for a system architecture that includes relational database information may be implemented in an object-oriented paradigm (see at least Co. 5, line 35-Col. 6, line 10).

Therefore, it would have been obvious to one of ordinary skill in the art of electronic-commerce to combine Schein and Owens to apply an object-oriented paradigm and describe plurality of financial products in terms of plurality of classes and plurality of objects.

One of ordinary skill in the art of electronic-commerce would have been motivated to combine Schein and Owens to apply an object-oriented paradigm and describe plurality of financial products in terms of plurality of classes and plurality of objects for the obvious reason that the use of objects and classes to describe data allows a clearer view of how data interacts with business applications. Applying object-oriented terms permits one of ordinary skill in the art to reuse program code (classes) by instantiating a class into one or more objects that correspond to data items retrieved and used by different sub-systems.

The information on the centralized database is available to each of the client system databases for each transaction, and the transaction request is linked to a customer's products. In an object-oriented world, a customer may create (open/add/insert or other term) one or more financial product, including stored value products, and each product may be associated with an object. This plurality of *objects* may also be referred to as a first, second, through nth product, just as the plurality of client systems may be referred to as a first client system, a second client system, etc.).

Conclusion

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JZ
James Zurita
Patent Examiner
Art Unit 3625
November 17, 2002


JEFFREY A. SMITH
PRIMARY EXAMINER